

R E M A R K S

A. INTRODUCTION

Claims 1-58 are pending and rejected.

No amendments of any kind are provided with this reply.

B. SECTION 102(E) AND 103(A) REJECTIONS

Claims 1-4, 6-16, 21-44, 49-54 and 56-58 stand rejected under 35 U.S.C. 102(e) as being anticipated by Herman (U.S. Patent No. 6341353).

Claims 5, 17-20, 45-48 and 55 stand rejected under 35 U.S.C. 103(a) as unpatentable over Herman in view of U.S. Patent No. 6,161,059 issued to Tedesco et al. ("Tedesco").

We respectfully traverse the Examiner's Section 102(e) rejection and Section 103(a) rejections. We respectfully submit that the Examiner has not established a *prima facie* case of obviousness for any of the independent claims (Claims 1, 6, 44, 51, and 56) or any of the dependent claims (Claims 2-5, 7-43, 45-50, 52-55, 57, and 58). Further, neither Herman nor Herman in the asserted combination with Tedesco can support an obviousness rejection of any pending claim.

1. This Application

This application was actually filed on May 21, 1999.

This application claims the benefit of priority of U.S. Patent Application No. 08/920116, filed August 26, 1997, which claims the benefit of priority of U.S. Patent Application No. 08/822709, filed March 21, 1997.

After initially determining that 08/920116 disclosed all of the subject matter of all of the independent claims (see Office Action mailed November 13, 2002, pages 2-7), the Examiner has changed his assessment of that application. The Examiner now asserts that 08/920116 does not support the feature of: "receiving an acceptance of the offer by the customer on the record of charge.... Instead, a cashier processes an upsell by pressing a selection button on a POS terminal (see Abstract of 08/920,116)." [Office Action, page 2].

We do not necessarily agree or disagree with the Examiner's new assessment of the pending claims and the disclosure of 08/920116, or with the Examiner's determination that 08/822709 also does not support the subject matter of the pending claims. As discussed below, reliance on the priority of that application is not necessarily in order to overcome the pending rejections.

2. The Herman Reference

Herman was filed on December 10, 1999, after the actual filing date of the present application.

Herman is a continuation-in-part (CIP) of an application filed April 11, 1997, that issued as U.S. Patent No. 6,119,229 (Martinez). The Examiner explicitly “has only relied upon the provisional application, filed 12 December 1998, to establish priority and provide an effective 102(e) date.” [Office Action mailed June 2, 2005, page 3].

Herman claims the benefit of priority of Herman PRO (U.S. Provisional Patent Application No. 60/111988), filed December 12, 1998.

3. Findings Required for Applying a § 102(e) Reference

The Examiner is relying upon the filing date of Herman PRO as establishing an effective filing date for any asserted subject matter disclosed in Herman in the cited portions.

MPEP (8th ed., Rev. 5, August 2006) provides explicit instructions for making the findings necessary to establish a reference as a § 102(e) reference (underlining added):

§ 706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C. 102(e) [R-5]

I. DETERMINE THE APPROPRIATE 35 U.S.C. 102(e) DATE FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE GUIDELINES, EXAMPLES, AND FLOW CHARTS SET FORTH BELOW:

(A) The potential reference must be a U.S. patent...in order to apply the reference under 35 U.S.C. 102(e).

(B) ...The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph. See MPEP § 2136.02.

MPEP § 2136.03 (III) states: “The 35 U.S.C. 102(e) critical reference date of a U.S. patent...entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application...**if the provisional application(s) properly supports the subject matter**

relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.”

35 U.S.C. § 112, first paragraph provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

With respect to the written description requirement of Section 112, first paragraph, MPEP § 2163.02 provides:

The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

With respect to the enablement requirement of Section 112, first paragraph, MPEP § 2164 provides:

The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way. The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. >However, to comply with 35 U.S.C. 112, first paragraph, it is not necessary to "enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003) (an invention directed to a general system to improve the cleaning process for semiconductor wafers was enabled by a disclosure showing improvements in the overall system).< Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. A patent claim is invalid if it is not supported by an enabling disclosure.

MPEP § 2164.01 elaborates on the enablement requirement:

Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

Issues in dispute, therefore, are (1) whether the disclosure of Herman PRO allows persons of ordinary skill in the art to recognize that the cited portions of Herman were invented prior to the filing of our application, and (2) whether the description in Herman PRO would enable a person of ordinary skill to make or use what is described in the cited portions of Herman without undue experimentation.

4. Cited Portions of Herman Relied on for Rejections

In the Office Action mailed December 16, 2004, with respect to independent Claim 1 the Examiner stated that Herman discloses "receiving an acceptance of the offer by the customer on the record of charge (column 47, lines 15-19 and Figure 24, step 2404)." [page 4].

With respect to independent Claims 6 and 44 the Examiner stated that Herman discloses "providing a benefit to the customer after receiving the acceptance (column 47, lines 8-19)." [pages 5, 9].

With respect to independent Claim 51, the Examiner stated that Herman discloses "providing the product to the customer (column 47, lines 8-19)." [page 9].

The rejections of dependent Claims 2, 3, 7, 25, 28, 29, 31, 40-43, 53, 57 and 58 explicitly depend upon Column 47, lines 8-19 of Herman.

These specific portions identified in this section and relied upon by the Examiner in rejecting independent Claims 1, 6, 44, and 51 will be referred to collectively in this paper as the "cited portions." Column 46, line 61 to Column 47, line 22 is reproduced here in its entirety:

Trusted Intermediary

The invention acts as an [sic] trusted intermediary. This is particularly useful when multiple parties that do not necessarily trust each other to interact are involved in a transaction.

A further embodiment of the invention acts as an impartial fair witness in negotiation situations. Using the Smart Receipt

constructs described above, the invention provides a detailed record of the chain of events that occur during a negotiation.

Referring to FIG. 23, a Trusted Agent Server 2302 sits between a client X 2301 and a client Y 2303. The Trusted Agent Server 2302 acts as the trusted intermediary between the two parties X 2301 and Y 2303.

With respect to FIG. 24, this scenario example has user X offering to enter negotiations with user Y. The order object in the Smart Receipt chain 2401 is X's offer to enter into negotiations 2402. Y then responds with a positive confirmation 2403. Each LEDO has a unique owner, here, X owns the offer LEDO 2402 and Y owns the acceptance LEDO 2403.

X then begins the negotiations by issuing an offer object 2404 which is a LEDO attached to the current Smart Receipt chain. Y issues a counter-offer object 2405. X then issues another offer object 2406. Y decides that the offer is acceptable and issues an acceptance object 2407.

As noted above, the Smart Receipt provides a detailed record of each step of the negotiations. Each step is a LEDO object in the Smart Receipt chain.

5. **The Examiner has not established by substantial evidence that the cited portions of Herman are adequately described or enabled by Herman PRO**

The Examiner asserts, with respect to the cited portions:

Further, the section teaches LEDO's used for a negotiation. As mentioned above, the provisional application teaches that LEDOs are verifiable and are efficient for legal and business issues. Such negotiations are a clear example of a legal and business issues.

The Examiner's basis for finding support in Herman PRO thus rests entirely on an improper conclusion that Herman PRO would support any use of LEDOs described in Herman for any purpose that could be characterized in the abstract as a "legal or business issue."

Reliance on Herman PRO to establish priority for the cited portions is limited to what it actually describes and enables. Nothing in Herman PRO refers in any way to negotiation, would suggest that its authors considered negotiations a "clear example" of the legal and business issues generically referred to in Herman PRO, or otherwise would suggest that the authors of Herman PRO were in possession of an invention related to negotiation, much less the specific steps and features described in the cited portions.

Further, nothing in Herman PRO suggests that its authors were in possession of or had invented or enabled any of the following subject matter of the cited portions:

- embodiments for use as an impartial fair witness in negotiation situations
- providing a detailed record of the chain of events that occur during a negotiation
- a first user offering to enter negotiations with a second user
- use of “smart receipts” for any purpose other than “as the basis for after-market consumer care” (i.e. after a consumer buys a product) (see page 9 “Other Commerce Servers”) or “ongoing customer support” (see page 5)
- creation of “smart receipts” by any entity other than a “relationship marketing server” that sends information to a “trusted agent”
- a “smart receipt” comprising a “chain” of objects
- a “LEDO attached to the current Smart Receipt chain”
- a detailed record of each step of negotiations, in which each step is a LEDO object in a Smart Receipt chain

Accordingly, we submit that the cited portions of Herman are not supported by the disclosure of Herman PRO in accordance with Section 112, first paragraph—they are neither properly described nor properly enabled. One of ordinary skill in the art could not recognize, based only on Herman PRO, that its authors were in possession of the subject matter described in the cited portions and relied upon by the Examiner. Nor could one of ordinary skill in the art, relying only on what is actually disclosed in Herman PRO, arrive at the subject matter described in the cited portions without undue experimentation.

In conclusion, Herman PRO does not provide an effective filing date for the cited subject matter that is earlier than our application, Herman is not an effective § 102(e) reference for the cited portions, and the Section 102(e) and Section 103(a) rejections of independent Claims 1, 6, 44, and 51 (and their dependent claims 2-5, 7-43, 45-50, and 52-55) should be reconsidered and withdrawn.

6. Independent Claim 56

With respect to independent Claim 56, the Examiner stated that Herman discloses “receiving from the merchant a record of charger [sic] for the transaction, the record of charge including the purchase amount, and the record of charge including an indication of an offer (column 44, lines 15-21 and Figure 21).” [page 10].

Independent Claim 56 recites: *receiving, from the merchant, a record of charge for the transaction printed by a point-of-sale terminal*. The Smart Receipt described by Herman is not printed by a point-of-sale terminal. It is an “XML representation of the purchase that is consistent with Transactor Networks Inc.’s Smart Receipt Document Type Description (DTD” and is “transported and stored in LEDO in XML format.” This is not hint in Herman that any Smart Receipt may be printed, much less *printed by a point-of-sale terminal*, much less would be printed *including an indication of an offer*, as recited in Claim 56.

Accordingly, we submit that the Examiner has failed to establish a prima facie case of anticipation for independent Claim 56 (and dependent Claims 57 and 58). Further, Herman does not teach the receiving step of Claim 56. We respectfully request that the Examiner reconsider and withdraw the Section 102(e) rejection of Claims 56-58.

C. ADDITIONAL COMMENTS

Our silence with respect to the Examiner’s other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, or the Examiner’s interpretation of claimed subject matter, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case of obviousness for any of the pending claims, for the reasons stated in this paper, we need not address the Examiner’s other assertions at this time.

D. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a three-month extension of time to respond to the Office Action is necessary. Please grant a petition for any extension of time required to make this Response timely.

Charge: \$1020.00

Deposit Account: 50-0271

Order No.: 99-012

Please charge any appropriate fees set forth in §§ 1.16 – 1.18 for this paper and for any accompanying papers to Deposit Account 50-0271. Please credit any overpayment to the same account.

E. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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